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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,069	09/02/1998	TAKEHIRO YOSHIDA	1232-4467	6726
27123	7590	06/22/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 06/22/2005.

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/146,069	YOSHIDA, TAKEHIRO	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16, 18-20 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16, 18-20 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/9/05, and has been entered and made of record. Currently, **claims 12-16, 18-20, and 26-29** are pending.
2. The indicated allowability of **claims 12-16, 18-20, and 26-29** is withdrawn in view of the reference(s) to Ishibashi *et al.* (U.S. Patent Number 6,374,291) and Okutomi *et al.* (U.S. Patent Number 6,211,972). While both of the references were previously cited in the Office action dated 1/29/04, upon a thorough review of the cited prior art, the examiner believes that one of ordinary skill in the art would find the combination of Ishibashi *et al.* in view of Okutomi *et al.* as an obvious modification. Rejections based on the newly cited reference(s) follow.

Response to Arguments

3. Applicant's arguments filed 7/23/04, which were filed with the amendment that placed the claims in their current basic form, and which argued that the claims have distinguishing features over the rejection that was cited 1/29/04 under 35 U.S.C.103(a) as being unpatentable over Ishibashi *et al.* in view of Okutomi *et al.*, have been fully reconsidered, but they are not persuasive.
4. Particularly, Ishibashi can be interpreted as teaching each of the limitations, but failing to expressly disclose of causing the notification unit not to perform a notification operation when the number of pages of the facsimile information to be transmitted from the transmitting station to the receiving station is not more than a predetermined value. Okutomi teaches of a control

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unit that does not perform a facsimile operation when the number of pages of the facsimile information to be transmitted from the transmitting station to the receiving station is not more than a predetermined value. Because of this, it would have been obvious to a person of ordinary skill in the art to include the control unit teachings of Okutomi within the notification unit of Ishibashi, so as to include a control unit configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile data to be transmitted through the Internet is not more than a predetermined value. The suggestion/motivation for doing so would have been that Ishibashi's system would reduce costs of transmitting data by facsimile through the PSTN, by not performing the notification when the number of pages is greater than a predetermined value. Therefore, it would have been obvious to combine Okutomi's teachings with the system of Ishibashi to obtain the invention as specified in independent claims 12, and 18-20.

Claim Objections

5. **Claims 15, 18-20, and 27-29** are objected to because of the following informalities:

In **claim 15**, line 2, "said notification means" should read "said notification unit";

in **claim 18**, lines 8 and 9, "by said Internet communication execution unit" and "said notification unit" should be removed or included as part of the particular function to have sufficient antecedent basis for the particular "units";

in **claim 19**, lines 10-12, "by said Internet communication execution unit" and "said notification unit" should be removed or included as part of the particular function to have sufficient antecedent basis for the particular "units";

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in **claim 20**, line 2, “transmission means” should read “Internet communication execution unit”;

in **claim 27**, line 1, “apparatus” should read “control method”;

in **claim 27**, lines 1-4, “said control unit”, “said Internet communication execution unit” and “said notification unit” should be removed or included in claim 18 as part of the particular function to have sufficient antecedent basis for the particular “units”;

in **claim 28**, line 1, “apparatus” should read “computer readable storage medium”;

in **claim 28**, lines 1-4, “said control unit”, “said Internet communication execution unit” and “said notification unit” should be removed or included in claim 19 as part of the particular function to have sufficient antecedent basis for the particular “units”;

in **claim 29**, line 2, “from station A to the station B” should be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 12, 13, 15, 18-20 and 26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291, cited in the Office action dated 1/29/04) in view of Okutomi *et al.* (U.S. Patent Number 6,211,972, cited in the Office action dated 1/29/04).

Regarding *claims 12, 18, and 19*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2), having a control method, and a computer-readable storage medium (ROM 6), which stores a program for controlling the communication apparatus (column 3, lines 46 through 54), capable of facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), comprising an Internet communication execution unit configured to establish a dial-up connection from a station A to an Internet service provider to execute a facsimile communication with a station B (see abstract, Fig 3, and column 7, lines 11 through 60, being steps S9-S13 in Fig. 6) having a TCP/IP address through the Internet (column 5, lines 28 through 60), a notification unit configured to notify the station B via the PSTN (see abstract, column 7, lines 26 through 55, and Fig. 11, being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) of report information representing that a facsimile has been sent to the station B through the Internet and description information of the facsimile (see Fig. 11), when the facsimile communication has been executed by the Internet communication execution unit (column 9, line 12 through column 10, line 14), and a control unit configured to cause the notification unit not to perform notification operation (CPU 1, column 3, line 29-column 4, line 44).

However, Ishibashi fails to particularly teach if the control unit is configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Okutomi discloses a communication apparatus (see Fig. 3), having a control method, and a computer-readable storage medium (ROM 2), which stores a program for controlling the communication apparatus (column 3, lines 6 through 11), capable of facsimile

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communication through the Internet (see Fig. 2), comprising an Internet communication execution unit configured to establish a connection from a station A to execute communication with a station B having a TCP/IP address (see Fig. 6) through the Internet (step S83 in Fig. 15, column 7, lines 38 through 47), a notification unit configured to notify the station B via the PSTN of report information representing a facsimile (column 7, lines 48-54), and a control unit is configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (see Fig. 14, column 6, line 48-column 7, line 20).

Ishibashi & Okutomi are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the control unit teachings of Okutomi within the notification unit of Ishibashi, so as to include a control unit configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile data to be transmitted by the transmission means through the Internet is not more than a predetermined value. The suggestion/motivation for doing so would have been that Ishibashi's system would reduce costs of transmitting data by facsimile through the PSTN, by not performing the notification when the number of pages is greater than a predetermined value. Therefore, it would have been obvious to combine Okutomi's teachings with the system of Ishibashi to obtain the invention as specified in claim 12, 18, and 19.

Regarding **claim 20**, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising transmission means for transmitting facsimile data via the Internet (see abstract, column 6, line 35 through column 7, line 25), a notification unit configured to notify a recipient, via the PSTN (see abstract, column 7, lines 26 through 55, and Fig. 11, being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) of report information representing that a facsimile has been sent to the recipient through the Internet and description information of the facsimile (see Fig. 11), when the facsimile communication has been executed by the Internet communication execution unit (column 9, line 12 through column 10, line 14), and a control unit configured to cause the notification unit not to perform notification operation (CPU 1, column 3, line 29-column 4, line 44).

However, Ishibashi fails to particularly teach if the control unit is configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile data to be transmitted by the transmission means through the Internet is not more than a predetermined value. Okutomi discloses a communication apparatus (see Fig. 3) comprising a control unit configured to cause a notification unit, configured to notify a recipient via the PSTN (column 7, lines 48-54), not to perform a notification operation, when the number of pages of facsimile data to be transmitted by a transmission means through the Internet is not more than a predetermined value (see Fig. 14, column 6, line 48-column 7, line 20).

Ishibashi & Okutomi are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the control unit teachings of Okutomi within the notification

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unit of Ishibashi, so as to include a control unit configured to cause the notification unit not to perform notification operation, when the number of pages of the facsimile data to be transmitted by the transmission means through the Internet is not more than a predetermined value. The suggestion/motivation for doing so would have been that Ishibashi's system would reduce costs of transmitting data by facsimile through the PSTN, by not performing the notification when the number of pages is greater than a predetermined value. Therefore, it would have been obvious to combine Okutomi's teachings with the system of Ishibashi to obtain the invention as specified in claim 20.

Regarding *claim 13*, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, and Ishibashi further teaches that the description information is summarized text representing a summary of facsimile communication (see Fig. 11).

Regarding *claim 15*, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, and Ishibashi further teaches that *the notification unit* further transmits a number of pages of facsimile information transmitted through the Internet and a communication time (see Fig. 11).

Regarding *claims 26, 27, and 28*, Ishibashi and Okutomi disclose the apparatus, method, and medium discussed above in claims 12, 18 and 19, respectively, and Okutomi further teaches of a control unit that transmits facsimile information from the station A to the station B through a general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than predetermined value (see Fig. 14, column 6, line 48-column 7, line 20).

Ishibashi & Okutomi are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the control unit teachings of Okutomi within the notification unit of Ishibashi, so as to include a control unit configured to transmit the facsimile information over a general public network, without performing communication by the Internet communication execution unit and notification operation by the notification unit, when the number of pages of the facsimile data to be transmitted is not more than a predetermined value. The suggestion/motivation for doing so would have been that Ishibashi's system would reduce costs of transmitting data by facsimile through the PSTN, by not performing the notification when the number of pages is greater than a predetermined value. Therefore, it would have been obvious to combine Okutomi's teachings with the system of Ishibashi to obtain the invention as specified in claims 26-28.

Regarding **claim 29**, Ishibashi and Okutomi disclose the apparatus discussed above in claim 20, and Okutomi further teaches of a control unit that transmits facsimile information through a general public network when the number of pages of the facsimile information to be transmitted through the Internet is not more than predetermined value (see Fig. 14, column 6, line 48-column 7, line 20).

Ishibashi & Okutomi are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the control unit teachings of Okutomi within the notification

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unit of Ishibashi, so as to include a control unit configured to transmit the facsimile information over a general public network, without performing communication by the Internet communication execution unit and notification operation by the notification unit, when the number of pages of the facsimile data to be transmitted is not more than a predetermined value. The suggestion/motivation for doing so would have been that Ishibashi's system would reduce costs of transmitting data by facsimile through the PSTN, by not performing the notification when the number of pages is greater than a predetermined value. Therefore, it would have been obvious to combine Okutomi's teachings with the system of Ishibashi to obtain the invention as specified in claim 29.

8. **Claims 14 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291, cited in the Office action dated 1/29/04) in view of Okutomi *et al.* (U.S. Patent Number 6,211,972, cited in the Office action dated 1/29/04), and further in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 1/29/04).

Regarding **claim 14**, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising an Internet communication unit configured to performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and a notification unit

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configured to notify the station B of report information (step 56, column 7, lines 6 through 8, and column 8, line 22 through column 9, line 37), when the facsimile communication has been executed (process of Fig. 2). Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17).

Ishibashi, Okutomi, and Bobo are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the description information teachings of Bobo within the system of Ishibashi and Okutomi. The suggestion/motivation for doing so would have been that Ishibashi and Okutomi's system would become more user-friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message. Therefore, it would have been obvious to combine Bobo's teachings with the system of Ishibashi and Okutomi to obtain the invention as specified in claim 14.

Regarding *claim 16*, Ishibashi and Okutomi disclose the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet.

Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising an Internet communication unit configured to performing dial-up connection from a station A (facsimile 24) to an Internet

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service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and a notification unit configured to notify the station B of report information (step 56, column 7, lines 6 through 8, and column 8, line 22 through column 9, line 37), when the facsimile communication has been executed (process of Fig. 2). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 30).

Ishibashi, Okutomi, and Bobo are combinable because they are from a similar problem solving area, that being fax/e-mail systems that attempt to reduce costs of messages sent by electronic mail and by facsimile. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the description information teachings of Bobo within the system of Ishibashi and Okutomi. The suggestion/motivation for doing so would have been that Ishibashi and Okutomi's system would become more user-friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message. Therefore, it would have been obvious to combine Bobo's teachings with the system of Ishibashi and Okutomi to obtain the invention as specified in claim 16.

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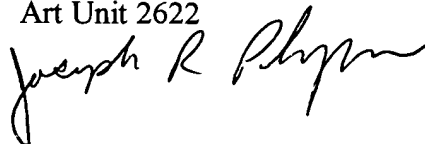
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrp